



D-1077+6

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants:	<b>Drummond, et al.</b>	)	
		)	
Application No.:	<b>09/193,564</b>	)	Art Unit 3621
		)	
Confirmation No.:	<b>2181</b>	)	
		)	
Filed:	<b>November 17, 1998</b>	)	Patent Examiner
		)	Pierre Eddy Elisca
		)	
Title:	<b>Automated Banking</b>	)	
	<b>Machine and System</b>	)	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**4TH REPLY BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 41.41**

Sir:

The Appellants hereby submit their 4th Reply Brief concerning the above-referenced Application. This Reply Brief is filed pursuant to 37 C.F.R. § 41.41 in response to the Order dated 6/19/2008 from the Board of Patent Appeals and Interferences ("Board"), and the 3rd Examiner's Answer dated 12/26/2006. The Examiner's Answer ("Answer") is the result of a several Remand/Orders to the Examiner from the Board.

### **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is  
Diebold, Incorporated, an Ohio corporation.

## STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims rejected: 1-20

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The questions presented in this appeal are:

- 1). Whether claims 1-4, 7-8, 10-14, and 17-20 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Anderson, et al. (US 5,706,442) (hereinafter "Anderson").
- 2). Whether claims 5-6, 9, and 15-16 are unpatentable pursuant to 35 U.S.C. § 103(a) over Anderson in view of Zeanah, et al. (US 5,933,816) (hereinafter "Zeanah").

## **ARGUMENT**

The following dates and papers are associated with this application:

1. 04/20/01 Non final Rejection
2. 09/26/01 Final Rejection
3. 01/29/02 Appeal Brief
4. 04/09/02 1st Examiner's Answer
5. 05/09/02 1st Reply Brief
6. 09/18/02 Order from Board to Examiner
7. 10/29/02 2nd Examiner's Answer
8. 01/28/03 2nd Reply Brief
9. 07/12/04 Remand from Board to Examiner
10. 06/07/05 Order from Board to Examiner
11. 08/31/06 3rd Examiner's Answer
12. 10/27/06 Order from Board to Examiner
13. 12/26/06 4th Examiner's Answer
14. 02/07/07 3rd Reply Brief
15. 06/19/08 Order from Board to Appellants

### **Appellants' Reply to the "Grounds of Rejection" section of the Answer**

As best understood, the rejections set forth (at pages 3-10) in the Answer appear to correspond to the grounds previously presented in the Office Actions dated 9/26/2001 and 4/20/2001, from which appeal was initially taken. Thus, Appellants respectfully submit that the

rejections set forth in the Answer have already been fully addressed in Appellants' Appeal Brief filed on 1/29/2002. Therefore, please note Appellants' previous arguments (in their Appeal Brief) regarding all the issues of record.

**Appellants' Reply to the "Response to Argument" Section of the Answer**

The Answer includes a "Response to Argument" section beginning on page 10. However, this section provides no new support for the rejections. Most of this section's "answer" consists of merely repeating the allegations already presented in the "Grounds of Rejection" section of the Answer. Thus, Appellants respectfully submit that the Office's "answer" has already been fully addressed in Appellants' Appeal Brief. The Office still has not provided any evidence of anticipation nor any factual support for a *prima facie* conclusion of obviousness. Furthermore, the "Response to Argument" section of the Answer only addresses a portion of Appellants' many arguments made in the Appeal Brief in support of allowance.

Appellants respectfully submit that the Examiner also fails to correctly ascertain the level of one having ordinary skill in the art. This application claims priority back to 1996. Appellants respectfully submit that the Office did not reach a conclusion based on facts gleaned only from the prior art. That is, the Office incorrectly attempts to apply today's level of one having ordinary skill in the art. The Office's attempted usage of hindsight to breathe life into the many allegations set forth in the rejections is legally impermissible.

The Answer only addresses what are designated as issues "a," "b," "c," and "d." As best understood, issues "a," "b," and "c" only correspond to steps a, b, and c of claim 1. As best understood, issue "d" only corresponds to the "accessing a document" step of claim 2.

## **Claim 1**

### **Issue A**

As previously noted, as best understood, issue "a" is directed to step (a) of claim 1.

Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Answer (on page 10) tries to rebut Appellants' Appeal Brief arguments (on pages 9-10) that Anderson does not teach "At least one HTTP record which includes data corresponding to operating data, where the operating data is operative to control operation of an automated transaction machine." The Answer alleges that the features are disclosed by Anderson at col. 2, lines 21-47, which reads:

The Conductor System Architecture (Conductor) and its related protocols provide a robust suite of on-line Interfaces for use by applications, financial service providers, Web (hyper-text transfer protocol--HTTP) servers, and other clients to obtain and manipulate financial information for users of the system. Applying principles of modularity and abstraction, distributed systems technologies are used to define the major components of Conductor and their interrelationships to allow delivery of diverse types of financial services over a wide area network. Sources of data may be as varied as the Interfaces to it. Financial information systems using the approach of Conductor are easily extensible because Conductor is based on a platform-portable, language-independent distributed object framework. Client components and server components work in concert to provide timely financial information to users of an on-line financial information system built using Conductor. Use of the distributed approach of a client/server model permits the easy integration of new services and providers for the system. For example, server components of Conductor may easily serve as back-end resources for existing

on-line service providers. The distributed approach also allows applications running in the system to be accessible through a number of presentation tools or users interfaces (collectively, clients): for example, native Microsoft Windows applications, Web (hyper-text mark-up language--HTML) browsers, text-terminals, X.25 transactions, even voice telephony.

As can be seen, nowhere in this relied upon section does Anderson link HTTP records with operating data that can control operation of an automated transaction machine.

The Answer states that it specifically relies on the cited portion "on-line Interfaces for use by applications, financial service providers, Web (hyper-text transfer protocol--HTTP) servers, and other clients to obtain and manipulate financial information for users of the system." However, this relied upon portion of Anderson only discloses a suite of on-line interfaces that obtain and *manipulate financial information* for users of the system. Anderson's "financial information" doesn't constitute operating instructions for controlling operation of an automated transaction machine.

The Office does not read claim 1 as a whole. Anderson does not teach an HTTP record associated with operating data to control operation of an automated transaction machine (e.g., ATM). Nor is Anderson, as apparently alleged by the Office, directed to using an HTTP record to control ATM operation. Where does Anderson specifically teach an HTTP record associated with data (e.g., instructions) that can control operation of an automated transaction machine? Anderson doesn't. Anderson does not teach the recited relational links.

The Answer also alleges that "HTTP is for viewing a specific web page or to view a specific operating data at an automated transaction machine." However, Anderson does not teach

that "HTTP is for viewing a specific web page or to view a specific operating data at an automated transaction machine." Nor is there any prior art evidence of record that provides any support for the allegation.

Even if Anderson did teach the alleged "viewing," it is unclear how "viewing a specific web page" relates to an HTTP record associated with "operating data" that can "control operation" of an automated transaction machine. That is, "viewing" a web page is unrelated to controlling operation of an automated transaction machine.

Furthermore, it is unclear how one could "view a specific operating data," especially using HTTP, as alleged by the Office. It is also unclear how something that is "viewed" is operative to control operation of a machine. The Office does not explain the rejection. Nor can it, because the rejection is unsupported, inapplicable, and unreasonable. Anderson does not anticipate claim 1.

#### **Issue B**

As previously noted, as best understood, issue "b" is directed to step (b) of claim 1. Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Answer (on page 10) tries to rebut Appellants' Appeal Brief argument (on page 10) that Anderson does not teach "accessing a record data through a server with a computer in an automated transaction machine." The Answer alleges that the features are disclosed by Anderson at col. 2, lines 20-25, 33-39, and 51-67, which reads:

The Conductor System Architecture (Conductor) and its related protocols provide a robust suite of on-line Interfaces for use by applications, financial service providers,

Web (hyper-text transfer protocol--HTTP) servers, and other clients to obtain and manipulate financial information for users of the system. (lines 20-25);

Client components and server components work in concert to provide timely financial information to users of an on-line financial information system built using Conductor. Use of the distributed approach of a client/server model permits the easy integration of new services and providers for the system. (lines 33-39); and

Preferably, users connect to the suite of on-line financial services in the Conductor Network via the Internet 12. Methods for providing services via the Internet are well-known in the art and are not explained here. Host computers in the network are accessible worldwide from any site with TCP/IP name resolution and packet routing to the conductor.com domain. Preferably, host computers running the Windows NT Operating System and the UNIX Operating System are used in the distributed environment. Clients and servers may run on any of twenty operating systems. Multiple user interfaces to applications that are part of the Conductor Network are implemented as different types of clients. As shown in FIG. 1, a user may communicate with a financial application via a Web (hyper-text markup language--HTML) browser 10 or via the CompuServe Information Service 14 using the CompuServe Information Manager for Windows (WinCIM) 16. (lines 51-67).

The Appellants respectfully disagree. Again, the Office does not read claim 1 as a whole. The Office ignores that claim 1, step (b), recites "accessing the record data through the server with a computer in an automated transaction machine," where (from step a) the record data corresponds to operating data that can control automated transaction machine operation.

Anderson does not teach accessing an HTTP record through a server using "a computer in an automated transaction machine," especially where the HTTP record is associated with operating data that can control operation of the automated transaction machine. At best, the relied upon sections of Anderson only disclose a generic client-server relationship between computers to access financial information. Again, Anderson cannot anticipate claim 1.

### **Issue C**

As previously noted, as best understood, issue "c" is directed to step (c) of claim 1. Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Answer (on page 11) tries to rebut Appellants' Appeal Brief argument (at the paragraph bridging pages 10-11) that Anderson does not teach "loading data corresponding to operating data in a memory of the machine." The Answer alleges that the features are disclosed by Anderson at col. 4, lines 45-67 and Figure 2, which reads:

Referring to FIG. 2, a diagram of the client and server components of a financial information system based on the Conductor System Architecture is shown. Among the server components supported by Conductor are databases. For example, financial information of interest to users of the system is contained in different databases 28, 34, 40 within the distributed environment. Each database has its own access mechanism 26, 32, 38. As explained earlier, among the methods for accessing a system based on the architecture are a Web (hyper-text markup language-HTML) browser 10 that communicates through a Web Server 20 or a native Windows application 12. Regardless of the user interface or client in operation (e.g., Web browser 10 or Windows application 12), a financial information request that includes the name of a financial information service 42, 44 may be transmitted from the client 10, 12 to be processed by the name

server 22. In the case of the Windows application 12, the financial information request 42 may be transmitted directly to the name server 22. In the case of the Web browser 10, the financial information request may be processed through a Web server 20 that communicates with the name server 22 to determine the location of the financial server to process the request. This approach therefore allows financial services to be implemented as objects.

The Appellants respectfully disagree. The relied upon section of Anderson does not teach recited step (c). Again, the Office does not read claim 1 as a whole. The Office ignores that claim 1, step (c), actually recites "loading data corresponding to the operating data in a memory of the machine." That is, "the operating data" refers back to the (step a) operating data that is operative to control operation of the automated transaction machine, and "the operating data" is associated with an HTTP record accessed in step (b).

Anderson does not teach loading data into a memory of an automated transaction machine, especially where the data is associated with controlling operation of the machine, and further especially where the data is associated with an accessed HTTP record. At best, the relied upon section of Anderson only discloses that financial information of interest to users is contained in different databases (28, 34, 40). However, these databases do not constitute a memory of an automated transaction machine. Nor does the financial information stored in these databases constitute "operating data" that can "control the operation" of an automated transaction machine. Again, Anderson cannot anticipate the claim 1.

In review, Anderson fails to teach providing a plurality of HTTP records accessible through an HTTP server, where at least one record data corresponds to operating data to control

an automated transaction machine; accessing the record data through the server with an automated transaction machine computer; and loading data corresponding to the operating data in memory of the automated transaction machine.

#### **Issue D**

#### **Claim 2**

As previously noted, as best understood, issue "d" is directed to the "accessing a document" step of claim 2. Claim 2 was rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Answer (on page 11) tries to rebut Appellants' Appeal Brief argument (on page 15) that Anderson does not teach "accessing a document with a browser operating in a computer of the automated transaction machine." The Answer alleges that the features are disclosed by Anderson at col. 2, lines 61-67, which reads:

Multiple user interfaces to applications that are part of the Conductor Network are implemented as different types of clients. As shown in FIG. 1, a user may communicate with a financial application via a Web (hyper-text markup language--HTML) browser 10 or via the CompuServe Information Service 14 using the CompuServe Information Manager for Windows (WinCIM) 16.

The Appellants respectfully disagree. Claim 2 recites that "step (b) comprises accessing a [HTML] document with a browser operating in a computer of the automated transaction machine," which Anderson does not teach. Anderson does not teach using an automated

transaction machine browser to access operating data via HTML documents to control operation of the machine.

As previously discussed, Anderson does not teach having HTTP records (or HTML documents) associated with data (e.g., instructions) operative to control operation of an automated transaction machine. Nor does Anderson teach accessing an HTML document with a browser, especially where the browser operates in a computer in an automated transaction machine, and further especially where the HTML document is associated with data operative to control operation of the machine.

The Office apparently realizes the deficiency in Anderson for the relied upon teaching, because the Answer (at page 11, line 8) further alleges that "on-line financial service information *can* also be interpreted as an ATM" (i.e., the alleged automated transaction machine). The Appellants also respectfully disagree with this allegation. Nor is the allegation factually supported in Anderson. The allegation at best smacks of attempted "obviousness."

Nor is the allegation reasonable to one skilled in the art. It is unclear how "information" could be interpreted as a "machine", especially an ATM. The Office misinterprets the claims and also improperly attempts to redefine well-established terms in the art.

Further, anticipation may not be established based on probabilities or possibilities (such as what Anderson's financial service information may be alleged as). *In re Robertson*, 169 F.3d 743, 49 USPQ 2d 1949 (Fed. Cir. 1999).

As previously discussed in the Appeal Brief, Anderson does not teach a "machine." It follows that Anderson cannot teach the specifically recited "automated transaction machine" or the automated transaction machine "browser."

Anderson does not anticipate claim 2. Therefore, Appellants respectfully submit that the 35 U.S.C. § 102(e) rejections should be withdrawn.

**Continuation of Appellants' Reply to the "Response to Argument" Section of the Answer**

**35 U.S.C. § 103(a) Issues**

The Answer (on page 11) tries to rebut some of Appellants' Appeal Brief arguments against the Anderson/Zeanah rejections of dependent claims 5-6, 9, and 15-16. The Office does not address all of the Appellants' arguments concerning these claims.

The Office admits (at Answer page 6) that Anderson fails to teach or suggest that "operating data includes applets" (e.g., claims 5 and 9 [and 18]). The Office alleges that Zeanah teaches "operating data that includes applets or java" at col. 19, lines 26-33; col. 22, lines 26-30; col. 28, lines 41-48, and the Abstract. The Appellants respectfully disagree.

The Appellants respectfully submit that the Office does not read the dependent claims as a whole, but rather in a vacuum. Appellants respectfully submit that Zeanah cannot overcome both the admitted and previously discussed deficiencies of Anderson. Zeanah does not disclose or suggest the recited features and relationships which are not found in Anderson. For example, Zeanah does not teach or suggest (e.g., claim 5/1) a data store which includes a plurality of records with operating data that can control operation of an automated transaction machine, especially where the operating data includes applets.

The Office has not established a *prima facie* showing of obviousness. Appellants have shown that neither Anderson nor Zeanah, taken alone or in combination, teaches or suggests the recited features and relationships. The Answer is also devoid of any teaching, suggestion, or motivation for combining features of the references as alleged. Nor would it have been obvious

to one having ordinary skill in the art to have modified Anderson as alleged to have produced Appellants' recited invention. Nor would the alleged modification of Anderson (if somehow even possible) have resulted in the recited invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

### **The References**

#### **The Anderson Reference**

Anderson is directed to a system and method for delivering financial information. The distributed system is called a "Conductor System Architecture" which is apparently a service mark of Anderson's assignee (col. 2, lines 20-25). The system permits client components and servers to work in concert to provide access to financial information (col. 1, lines 10-16; col. 2, lines 1-2). The system permits users to review activity and balances relating to different types of accounts (col. 1, lines 10-16; col. 2, lines 1-2).

Anderson's "Conductor" system is a computer software system based on a distributed architecture. Within the system, the TCP/IP protocol is used for communication between components of the system which allows access to financial information through the Internet or a proprietary network such as Compuserve® (col. 1, lines 56-62). The "Conductor" system architecture is based on a common object request broker architecture (CORBA) compliant distributed object computing platform. Primary system components include financial object servers, distributed name servers, and database servers (col. 3, lines 17-23). Financial information is stored in various databases each of which has its own access mechanism (col. 4, lines 45-52).

### *The Zeanah Reference*

Zeanah, et al. ("Zeanah") is directed to a system and method for delivering financial services to users. The disclosure of Zeanah (both the patent and the provisional application) is incomprehensible due to lack of details concerning operation of the system. Due to Zeanah's confusing and inconsistent description and lack of disclosure on how the system could be made to operate, Appellants have been required to speculate as to how the Zeanah system could be made to operate. Therefore, the description of Zeanah herein or any comments related thereto shall not be construed as agreement or an admission by Appellants that the Zeanah system is capable of operation or of achieving any of the functions carried out by Appellants' system.

Zeanah's arrangement appears to have a delivery system (12) operatively intermediate of plural remote devices (14, 16, 18, 20, 24) and other computer data systems (e.g., a bank's internal computer system). Zeanah requires that all of the remote devices (including ATMs) communicate directly through the delivery system (12) in order to provide financial services through operation of the remote devices (Figure 1; col. 3, lines 63-67; col. 4, lines 54-56; col. 5, lines 44-60; col. 29, lines 20-35).

Zeanah's delivery system (12) acts like a host server. The remote devices pass along input data to the delivery system (12) which then performs services on behalf of the remote devices.

### **Additional Arguments (Previously Made)**

The instant Reply Brief is *not* a Substitute Appeal Brief replacing Appellants' original Appeal Brief. Rather, Appellants' Appeal Brief includes many more examples and arguments as to why the applied references do not anticipate the claims nor render the claims obvious. As a courtesy to the Board, some of these arguments are herein repeated as follows:

#### **Anderson does not anticipate the claims**

Appellants have shown above that Anderson does not anticipate claim 1 or claim 2.

#### **Claim 3**

Claim 3/2/1 further recites that the document includes instructions, and that in step (c) the operating data is loaded in memory responsive to the instructions in the document. Anderson does not teach accessing a document with instructions using a browser operating in a computer of an automated transaction machine (e.g., ATM). Anderson also fails to teach loading operating data in an ATM memory responsive to instructions in an HTML document accessed with a browser of the ATM. As Anderson does not teach these features, it is respectfully submitted that claim 3 is allowable.

#### **Claim 4**

Claim 4/1 further recites that prior to step (c), the method includes providing to the server, data representative of an identity of the machine. Claim 4 further recites that the record data accessed in step (b) is accessed responsive to the identity data. Anderson does not teach providing to an HTTP server, data representative of an identity of an ATM. In addition, Anderson does not teach accessing HTTP record data responsive to an identity of an ATM. Anderson does not anticipate claim 4.

### **Claim 7**

Independent claim 7 recites a system that comprises an HTTP server, and a plurality of records accessible through the server. At least one of the records includes transaction machine operating data therein. Claim 7 also recites that the system further includes an automated transaction machine. The automated transaction machine includes a computer and the computer includes a memory. In addition claim 7 recites that the system includes software executable in the computer. The software is operative to access the at least one record and to store data corresponding to the machine operating data in the memory of the automated transaction machine.

Anderson fails to teach a system comprising an HTTP server; records accessible through the server, with at least one record including machine operating data therein; an automated transaction machine including a computer, computer memory, and software executable in the computer; where the software can cause a record to be accessed and have data corresponding to the accessed record's operating data stored in the memory of the automated transaction machine.

As discussed previously with respect to claim 1, Anderson does not teach an "automated transaction machine", as alleged at page 11, line 8 of the Examiner's Answer. Again, one skilled in the art would not have confused "on-line financial service information" as an ATM.

Furthermore, Anderson does not teach transaction machine operating data, or a record accessible through an HTTP server that includes the automated transaction machine (e.g., ATM) operating data therein. Anderson also does not teach that software in an ATM is operative to access the record which includes ATM operating data therein. In addition Anderson does not

teach software in an ATM that is operative to store data corresponding to ATM operating data in the memory of the ATM.

It is respectfully submitted that Anderson does not disclose each and every element of the claimed invention arranged in the manner recited in claim 7, as is required to sustain the anticipation rejection. Appellants' claim 7 patentably distinguishes over the Anderson reference, and it is respectfully submitted that the 35 U.S.C. § 102(e) rejection has been overcome.

### **Claim 8**

Claim 8/7 recites that the transaction machine further comprises at least one transaction function device in operative connection with the computer. The transaction function device is changeable from a first condition to a second condition. Claim 8 also recites that the system further includes a second record accessible through the HTTP server. The second record includes further machine operating data. The software executable in the computer in the automated transaction machine is further operative to access the second record and to store data corresponding to the further machine operating data in the memory of the machine responsive to a change in condition of the transaction function device.

As discussed previously, Anderson does not teach an automated transaction machine (e.g., ATM). In addition, Anderson does not teach an ATM that includes a transaction function device that is changeable from a first condition to a second condition. The Action alleges that Anderson discloses an ATM with a transaction function device in Figure 2 and in Column 2, lines 21-47. However, nowhere in this cited portion of Anderson is there discussed an ATM or a transaction function device of an ATM, or any other device of an ATM that is operative to change from a first condition to a second condition. Rather, this portion of Anderson discloses

only a suite of on-line interfaces that obtain and manipulate financial information for system users. Anderson does not teach transaction function devices of an ATM.

In addition, even if it were somehow possible (which it isn't), to equate any of the devices of Anderson with a transaction function device of an ATM, Anderson still would not disclose accessing a second record and storing data corresponding to further machine operating data in a memory of an ATM "responsive to a change in condition of the transaction function device."

Anderson does not teach a second record accessible through an HTTP server which includes further machine operating data. Anderson also does not teach accessing such a second record with an ATM and storing data corresponding to the further machine operating data in ATM memory. In addition, Anderson does not teach doing anything in response to a change in condition of a transaction function device of an ATM. Thus, Anderson fails to teach an ATM computer operative to access a second record, and store data in ATM memory responsive to a changed condition of an ATM transaction function device. Anderson does not anticipate claim 8.

#### **Claim 10**

Claim 10/7 further recites that the machine operating data includes an instruction. The computer in the automated transaction machine is operative, responsive to operating data corresponding to the instruction in memory, to access an applet from the HTTP server.

In the Answer at page 6, the Office admits that Anderson fails to teach or suggest "applets" or that "operating data includes applets." Appellants concur with the Examiner. As the anticipation rejection is based on Anderson alone, in light of the Examiner's admission the claim 10 rejection is not legally valid.

### **Claim 11**

Claim 11/7 recites that the system further includes a data store in operative connection with the HTTP server. The plurality of records are stored in the data store. In addition, claim 11 recites that the HTTP server includes a database server.

Although Anderson discloses databases (28, 34, 40) which contain financial information of interest to users of the system (Column 4, lines 48-51), Anderson does not teach that the financial information stored in the databases (28, 34, 40) includes ATM operating data therein. Anderson does not teach a plurality of records stored in a data store, of which at least one of the records includes ATM operating data therein (claim 7). Anderson does not anticipate claim 11.

### **Claim 12**

Claim 12/7 further recites that the automated transaction machine includes a plurality of transaction devices. Further, the software executable in the computer in the automated transaction machine includes a browser. The computer memory in the machine includes at least one document address which corresponds to at least one of the transaction devices in the machine. Claim 12 further recites that the system includes a plurality of documents accessible through the HTTP server. At least one document corresponding to the document address includes the operating data. The computer of the automated banking machine is operative to access the at least one document corresponding to the document address with the browser, and to store data corresponding to the machine operating data in the accessed document in the memory of the machine.

Although Anderson discloses a browser (10) that accesses financial information through communication with a web server (20), Anderson does not teach an ATM that includes a

browser. As previously discussed, Anderson does not teach an ATM or transaction devices of an ATM. Anderson also does not teach an ATM with a document address stored in a memory which corresponds to one of the transaction devices of the ATM. Although Anderson discloses a web server (20), Anderson does not teach a document accessible through an HTTP server which includes operating data therein. In addition, Anderson does not teach that such a document corresponding to the document address, corresponds to a transaction device of an ATM.

Anderson does not teach an ATM with a computer that is operative to access with a browser, a document at a document address corresponding to a transaction device in the ATM. Furthermore, Anderson does not teach an ATM that is operative to store data corresponding to the machine operating data in the accessed document, in the memory of the ATM. As Anderson does not teach these features, then Anderson does not anticipate claim 12.

### **Claim 13**

Claim 13/8/7 further recites that the transaction devices include a sheet dispenser, and a second of the documents accessible through the HTTP server includes transaction machine operating instructions to operate the sheet dispenser. Claim 13 also recites that the software in the automated transaction machine is further operative to access the second document with the browser, and to cause the sheet dispenser to operate in response to the transaction machine operating instructions included in the second document.

Anderson does not teach a sheet dispenser. Further, Anderson does not teach software which is operative to cause a sheet dispenser to operate in response to transaction machine operating instructions included in a document accessed with a browser. Anderson does not anticipate claim 13.

#### **Claim 14**

Claim 14/7 recites that the system further comprises a network operatively connecting the computer in the automated transaction machine and the HTTP server, wherein the computer is operative to access the at least one record through the network.

Anderson does not teach an ATM with a computer that is operative to access a record that includes transaction machine operating data, especially through a network and an HTTP server.

Anderson does not anticipate claim 14.

#### **Claim 17**

Independent claim 17 is directed to a method. The method includes (a) providing a plurality of documents that are accessible through an HTTP server. At least one document includes data corresponding to operating data, where the operating data is adapted to control operation of at least one transaction function device of an automated transaction machine. The method further includes (b) accessing the at least one document through the HTTP server with an automated transaction machine. The automated transaction machine includes a browser, such that the at least one document is accessed with the browser. The method further includes (c) loading data corresponding to the operating data in a memory of the automated transaction machine; and (d) operating at least one transaction function device of the automated transaction machine responsive to the machine operating data that has been loaded (in step c) into the memory of the machine. None of these features and relationships are found in Anderson.

Anderson discloses a browser (10) that is operative to access financial information from a web server (20). Anderson does not disclose an automated transaction machine (e.g., ATM) or an ATM with a browser. However, even if it were somehow possible (which it isn't) for any

portion of Anderson to somehow be considered as teaching an ATM with a browser, Anderson still would not teach each and every feature recited in claim 17. For example Anderson still would not teach operating an ATM to access at least one document through an HTTP server, where the document includes data corresponding to operating data that is adapted to control operation of at least one transaction function device of the ATM.

The Action asserts that these features are taught in Anderson at: Figure 2; Column 2, lines 21-47; and Column 4, lines 45-67. Appellants respectfully disagree. These portions of Anderson disclose only a system with a suite of on-line interfaces that obtain and manipulate financial information from databases for system users. Nowhere in Anderson is there taught a transaction function device of an ATM. Further, nowhere in Anderson is there taught a document with "operating data" that can control operation of an ATM transaction function device.

As previously discussed, Anderson does not teach an ATM that accesses at least one document through an HTTP server. In addition, Anderson does not teach an ATM that uses a browser to access the at least one document. Also, as discussed previously, Anderson does not teach loading data corresponding to operating data in a memory of an ATM. Anderson further fails to teach operating a transaction function device of an ATM responsive to operating data loaded in a memory of the ATM, especially where a document accessed by the ATM through an HTTP server includes the data. Anderson does not anticipate claim 17.

#### **Claim 18**

Claim 18/17 further recites that in step (d) the at least one transaction function device includes a cash dispenser, and that the operating data includes an applet. Claim 18 also recites that step (d) further includes dispensing cash from the cash dispenser responsive to the applet.

Furthermore, in the Answer at page 6 the Office admits that Anderson fails to teach or suggest “applets” or that “operating data includes applets.” Thus, the Office admits Anderson can't anticipate claim 18. Appellants concur with the Examiner.

Anderson also does not teach a cash dispenser. It follows that Anderson further does not teach dispensing cash from a cash dispenser responsive to an applet. It further follows that Anderson does not anticipate claim 18.

#### **Claim 19**

Claim 19/17 further recites: (e) accessing an applet with the automated transaction machine responsive to the operating data. In addition, claim 19 recites that step (d) includes operating the at least one transaction function device responsive to the applet.

As discussed previously, Anderson does not teach having operating data in at least one document that is adapted to control operation of at least one transaction function device of an ATM. As acknowledged by the Examiner (Answer at page 6), Anderson also does not teach an ATM that accesses an applet, especially in response to operating data. Anderson further does not teach operating a transaction function device of an ATM responsive to the applet. As Anderson does not teach these features, Anderson cannot anticipate claim 19.

#### **Claim 20**

Claim 20/19 recites that the at least one transaction function device (that is operated in step d) includes a cash dispenser. Again, Anderson does not teach a cash dispenser. It follows that Anderson cannot teach operating a cash dispenser of an ATM, especially in response to an applet assessed with the ATM. Nor can Anderson anticipate claim 20.

*The claims are not obvious over Anderson in view of Zeanah*

It would not have been obvious to one having ordinary skill in the art to have modified Anderson with the teaching of Zeanah in the manner alleged by the Office, especially to have produced the recited invention. The Answer does not factually support any *prima facie* conclusion of obviousness, in violation of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The rejections also do not identify a valid reason why a person having ordinary skill in the art would have combined the alleged features in the manner claimed, in violation of *KSR International Co. v. Teleflex Inc.*, U.S., No. 04-1350, 4/30/2007. Nor do the rejections provide any prior art teaching, suggestion, or motivation for combining elements of the cited references in the manner claimed. Rather, the rejections are based on pure allegations, instead of concrete prior art evidence of record, in violation of *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) and *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

**Claim 5**

Claim 5/1 recites that step (a) includes providing the plurality of HTTP records in a data store in operative connection with the HTTP server, such that the records include operating data, and the operating data includes applets.

As previously discussed, the Examiner (at Answer page 6) admits that Anderson fails to teach or suggest “applets” or that “operating data includes applets.” As best understood, the rejection is based on the allegation that Zeanah discloses applets, and that it somehow would have been obvious to a person of ordinary skill in the art at the time the invention was made, to have modified Anderson to have included an applet as taught by Zeanah.

However, neither Anderson nor Zeanah discloses or suggests a data store which includes a plurality of records with operating data that is operative to (step a) control operation of an ATM. Furthermore, neither reference discloses nor suggests that such operating data includes applets.

Thus, neither Anderson nor Zeanah, taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in claim 5. The Office has not established a *prima facie* case of obviousness. Nor has the Office provided any teaching, suggestion, motivation, or identified a valid reason why a person of ordinary skill in the art would have combined the elements of the cited references in the manner recited by Appellants.

#### **Claim 6**

Claim 6/1 further recites that step (a) includes providing the plurality of HTTP records in a data store in operative connection with the HTTP server, such that the records include operating data, and such that the operating data includes instructions executable by a computer to access applets.

As discussed previously, neither Anderson nor Zeanah discloses nor suggests a data store which includes a plurality of records with operating data that is operative to control operation of an ATM. In addition, neither reference discloses nor suggests that such operating data includes instructions executable by a computer to access applets.

The Office has not established a *prima facie* case of obviousness. Nor has the Office provided any teaching, suggestion, motivation, or identified a valid reason why a person of ordinary skill in the art would have combined the prior art elements of the cited references in the manner claimed.

### **Claim 9**

Claim 9/7 further recites that the machine operating data includes an applet. Neither Anderson nor Zeanah discloses or suggests an ATM with software that is operative to access through an HTTP server, a record that includes transaction machine operating data therein. In addition, neither reference discloses nor suggests that such ATM operating data includes an applet.

The Office has not established a *prima facie* case of obviousness. Nor has the Office provided any teaching, suggestion, motivation, or identified a valid reason why a person of ordinary skill in the art would have combined the prior art elements of the cited references in the manner claimed.

### **Claim 15**

Claim 15/7 further recites that the machine operating data includes Active-X code. Neither Anderson nor Zeanah discloses or suggests an ATM with software that is operative to access through an HTTP server, a record that includes transaction machine operating data therein. In addition, neither reference discloses nor suggests that such transaction machine operating data includes Active-X code.

The Office has not established a *prima facie* case of obviousness. Nor has the Office provided any teaching, suggestion, motivation, or identified a valid reason why a person of ordinary skill in the art would have combined the prior art elements of the cited references in the manner claimed.

### **Claim 16**

Claim 16/7 further recites that the machine operating data includes JAVA® code.

Neither Anderson nor Zeanah discloses or suggests an ATM with software that is operative to access through an HTTP server, a record that includes transaction machine operating data therein. In addition, neither reference discloses nor suggests that such transaction machine operating data includes JAVA® code.

The Office has not established a *prima facie* case of obviousness. Nor has the Office provided any teaching, suggestion, motivation, or identified a valid reason why a person of ordinary skill in the art would have combined the prior art elements of the cited references in the manner claimed.

### **Additional Comments**

The rules dictate that a brief is compliant as long as it includes the required items. That is, the rules merely specify the minimum requirements for a brief, and do not prohibit the inclusion of any other material which an Appellant may consider necessary or desirable.

### **The briefing requirement Order by the Board is not reasonable and lacks legality**

The Board has no legal authority to require Appellants (in their Reply Brief) to “repeat every argument that the Appellants want considered”, else “Any argument made in their earlier briefs not so repeated will be waived.” Nor does the Board have any authority to deny Appellants from referencing (in their Reply Brief) arguments from another paper already of record. Appellants respectfully request reconsideration. Appellants reserve all rights to petition.

The history of the USPTO shows that for many decades the Board easily reviewed all Appellant arguments made during an appeal, including arguments set forth in an Appeal Brief

and other arguments set forth in a Reply Brief. That is, the Reply Brief alone did not need to contain every argument that the Appellant wanted considered. Nor is a Reply Brief always required, as the Board mistakenly infers. For example, “Normally, appellant is *not* required to file a reply brief to respond to an examiner’s answer or a supplemental examiner’s answer, and if appellant does not file a reply brief . . . the application will be forwarded to the Board for decision on the appeal” (MPEP § 1208(I)). It follows that the Order’s statement that “Any argument made in their earlier briefs not so repeated will be waived” is without any legal merit. The Order by the Board is not reasonable because it contradicts the rules of the Office, which has jurisdiction over the Board.

The Federal Register also makes clear that even a Reply Brief that is filed in response to a new ground of rejection “*only* has to address the new ground of rejection.” Federal Register, Vol. 69, No. 155, 8/12/2004, page 49980, at comment 72. Again, the Order by the Board is unreasonable.

The Order by the Board is also not reasonable because no valid reason is provided in the Order for the requirement. Nowhere does the Board state why Appellants’ Reply Brief “must repeat every argument that the Appellants want considered.” The Order gives the wrong impression that the current Board panel, in comparison to earlier Board panels, is either unable or unwilling to read arguments from two separate papers (i.e., Appeal Brief and Reply Brief).

The Board’s reliance on *Putman v. Dudus*, 539 F.Supp.2d 414 (D.C.C. 2008) is misguided. *Putman* did not somehow grant the Board unlimited power to pick and choose on a case by case basis what they alone deem is a reasonable requirement. Nor can a Court grant additional power to the Patent Office’s Administrative Board. Regardless, nothing in *Putman*

indicates that the current briefing requirement Order by the Board is “reasonable.” Conversely, *Putman* indicates that the current Order by the Board should be viewed as “a mistake . . . Section [37 C.F.R. § 1.192 or 37 C.F.R. § 41.37] sets forth the requirements for filing an appeal brief. A separate section [37 C.F.R. § 1.193 or 37 C.F.R. § 41.41] applies to replies. Nothing in [37 C.F.R. § 1.192 or 37 C.F.R. § 41.37] suggests that arguments in an appeal brief must be repeated in a reply or they are waived.” *Putman*, 539 F.Supp.2d at 421.

The Order by the Board is further not reasonable because it appears to be arbitrary and capricious against Appellants. The Order by the Board provides no legal authority for a requirement that all Reply Briefs filed in the Office are now required to “repeat every argument that the Appellants want considered.” Instead, the record appears to indicate that the current Board panel is improperly acting independently and has unfairly targeted only Appellants.

The previous “instruction”

The Order by the Board indicates that Appellants were previously instructed in *Ex parte Drummond*, No. 2003-1621, at 3 (BPAI 7/12/2004) that any subsequent brief be self-contained with respect to all arguments. However, the Board overlooks the fact that the so called “instruction” to Appellants was actually in a Remand *to the Examiner*. As noted in *Putman*, “the Board remanded the application *to the examiner* – not because of anything the [Appellants] had done (or failed to do).” Why didn’t the Board attempt to notify Appellants of the “instruction” in a proper manner (e.g., under 37 C.F.R. § 1.196 or with a simple notification letter)? If the “instruction” was deemed to be as critical as the Board wants one to believe, then why weren’t Appellants properly notified? Unfortunately, the record now appears to give the impression that the Board purposely tried to hide an “instruction” to Appellants in a Remand to

the Examiner so they could later deny Appellants' already presented Appeal Brief arguments based on this hidden "instruction." The Appellants do not understand how the Board on one hand expects Appellants to separately read (and be bound by) papers directed solely to the Examiner (i.e., the many Remands/Orders to the Examiner), while on the other hand they themselves refuse to separately read only two papers (i.e., an Appeal Brief and a Reply Brief) which are directed to them.

The afforded period for reply is not reasonable

The record shows that since Appellants' Appeal Brief was filed on 1/29/2002 the Board issued five different Orders to the Examiner. In none of the Orders was there a set period for reply by the Examiner. The Orders to the Examiner dated 9/18/2002 and 7/12/2004 are similar to the current Order to Appellants in that they involve reference to another (earlier) paper. The record shows that the Examiner first replied to the 7/12/2004 Order on 3/23/2005. That is, the Examiner had over 8 months to reply. Yet the Board's current Order to Appellants affords only a 30 day period of reply (without any extension of time permitted) under the threat of appeal dismissal. In light of the Examiner's apparent unlimited time to reply, how is only 30 days a fair and reasonable time period for Appellants' reply? Appellants respectfully assert that the Board's Order is arbitrary, capricious, and undermines the impartiality of the appeal process.

The legal criteria for review

Appellants acknowledge the Board's statement (in the Remand dated 7/12/2004, at page 1) that *Ex parte Gambogi*, 62 USPQ2d 1209 (Bd.Pat.App. & Int. 2201) is the legal criteria for Board review. That is, "the Board is basically a board of review -- we review . . . rejections made by patent examiners." Appellants acknowledge that the Board's function is to *review rejections*.

That is, the Board is to review whether the Examiner met the Office's burden of establishing a legally valid rejection, not whether Appellants met some fictitious burden of proving error in the Examiner's actions.

## CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features thereof to produce the recited invention. Nor has the Office identified a valid reason for combining prior art features. Appellants' claims patentably distinguish over the applied references. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke  
Daniel D. Wasil  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029  
Reg. No. 45,303